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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,239	10/16/2003	Michael Gilfix	AUS920030360US1	8992

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EXAMINER	
THOMAS, JASON M	

ART UNIT	PAPER NUMBER
4126	

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12/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/687,239	GILFIX ET AL.	
	Examiner	Art Unit	
	JASON THOMAS	4126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10/16/2003* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *5/17/04, 11/01/06, 11/01/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to because:

   a. Item 406 of figure 5 has a typographical error in the word “identify”.

   b. Item 404 of figure 5 is not labeled.

   Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 12, 26 and 40 are objected to because of the following informalities:

Claims 12, 26 and 40 are improperly worded "further wherein".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 recites the limitation “visually designating an item comprises changing a video display of the item" in claim 4. There is insufficient antecedent basis for this limitation in the claim.

It would appear that claim 10 should depend on claim 7.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 29-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A computer program product for delivering interactive non-intrusive advertising content does not define any structural and functional interrelationship between the computer program product and other claimed

aspects of the invention which permit the computer program product's functionality to be realized. The claim language suggest that the claimed invention could be a signal due to the fact that it only comprises but is not limited to a recording medium. In contrast, a claimed computer recording medium encoded with a computer program or program product defines structural and functional interrelationships between the program product and the computer software and hardware components which permit the program product's functionality to be realized, and is thus statutory.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6-8, 10, 15-18, 20-22, 24, 29-32, 34-36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Broadwin et al. (U.S. Patent No. 5,929,850).

Regarding claims 1,15 and 29, Broadwin discloses a method, system and process (as indicated by the flow diagrams) for displaying (delivering) interactive advertising content, the method comprising: receiving a selection signal indicating that a user has selected an item displayed on a television screen, wherein the item has associated non-intrusive interactive advertising content; responsive to receiving the selection signal, identifying the selected item; and displaying the associated non-intrusive interactive advertising content (see

[figures 6, 8, 13, 14, 17 and 18], [column 3 lines 44-65], [column 5 lines 64-66], [column 7 lines 52-63] for receiving a selection signal from a remote control; see also [column 1 line 62 through column 2 line 8], [column 2 lines 53-66], [column 18 lines 4-18 and lines 48-55] for identifying and displaying the content associated with the user's selection).

Regarding claims 2, 16 and 30, Broadwin discloses all of the limitations of claim 1 including further comprising receiving and storing advertising data that associates the selected item with a screen region and with interactive advertising content (see [abstract], [figures 8, 13 and 14], [column 3 lines 15-23], [column 3 lines 24-43] for receiving and storing data; see also [column 3 lines 48-54], [column 10 lines 38-47], [column 18 lines 15-19] for an association with the advertising content).

Regarding claims 3,17 and 31, Broadwin discloses all of the limitations of claim 2 including wherein receiving the advertising data comprises receiving the advertising data encoded in a video signal that includes a video image of the item (see [figure 3], [column 3 lines 37-40], [column 6 lines 23-31], [column 6 lines 23-27], [column 7 lines 3-12] for receiving data video images over a video signal).

Regarding claims 4,18 and 32, Broadwin discloses all of the limitations of claim 2 including wherein the advertising data is encoded in a digital data stream separate from a video signal and receiving the advertising data comprises receiving the data stream through a digital network (see [figure 10] for a media server which transmits on a digital network; [column 3 lines 24-43], [column 3

lines 62-64], [column 6 lines 9-17], [column 13 lines 13-30] for a media or web server which maintains advertising data content).

Regarding claims 6, 20 and 34, Broadwin discloses all of the limitations of claim 1 further comprising: receiving one or more designation signals, wherein each designation signal represents an instruction to designate an item having associated non-intrusive interactive advertising content; responsive to receiving each designation signal, designating singly, as a currently designated item, each of a multiplicity of items having associated non-intrusive interactive advertising content; wherein identifying the selected item comprises identifying as the selected item the currently designated item (see [abstract], [column 7 lines 52-63] where a STB receives a signal designating a screen selection or button which is associated with a non-intrusive advertising content; see also [column 2 lines 61-67] where one of several still images which is linked to the user's selection is identified as corresponding to the selection and displayed).

Regarding claims 7, 21 and 35, Broadwin discloses all of the limitations of claim 6 including wherein designating singly each of a multiplicity of items further comprises logically designating an item and visually designating an item (see [column 2 lines 47-52], where the invention inherently requires the use of a logical designation to reference or link the MPEG stills with the appropriate interactive content; see also [column 2 lines 61-67] where the invention inherently requires the use of a logical designation to link the user selection with the corresponding still image; see also [column 3 lines 46-62] for a displayed

option which the user can view and select; see also [column 7 lines 52-63] for a visually designated selection or button which is displayed).

Regarding claims 8, 22 and 36, Broadwin discloses all of the limitations of claim 7 including wherein logically designating an item comprises setting a designation data element in advertising data for the item (see [column 10 lines 58 through column 11 line 12] where the advertising still image (data) includes an associated interactive program or content which is linked (designated) to the selected item).

Regarding claims 10, 24 and 38, Broadwin discloses all of the limitations of claim 7 including wherein visually designating an item comprises changing a video display of the item (see [figure 6, 13], [column 9 lines 33-40] where once a user selects one of the video still images displayed on the screen, the corresponding video still image is displayed on the screen thus the video display of item is changed).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 5, 19 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin et al. as applied to claims 2,16 or 30 above, and further in view of Wintendahl et al. (Pre-Grant Pub. No. 2002/0056136 A1).

Regarding claims 5, 19 and 33, Broadwin does not explicitly teach wherein the advertising data includes instructions for control of the display of interactive non-intrusive advertising content for the item.

Wistendahl teaches processing instructions for control of the display of interactive non-intrusive content for the item (see [0011], [0012], [0043] where the IDM module processes information sent to it to display either a pop-up window, overlay display, audio track, display of text, graphics, etc.; see also [0044] where the IDM module controls the display by instructing the content, per the user's request, to be played at a later time).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to have some controlling device such as the IDM to control the display of the interactive content by means of instructions, as taught in Wistendahl, to facilitate the proper or desired display of advertisements, as

taught in Broadwin, because this would further allow advertisers to display their advertisements in a more tailored thus more effective way (see Broadwin column 1 line 66 through column 2 line 8).

7. Claims 9, 23 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin et al. as applied to claims 7, 21 or 35 above, and further in view of Wistendahl et al.

Regarding claims 9, 23 and 37, Broadwin does not explicitly teach wherein visually designating an item comprises displaying descriptive text for the item.

Wistendahl teaches wherein visually designating an item comprises displaying descriptive text for the item (see [0043], [0064] where a user's click (designation) can initiate a linked display of text; see also [0065] where a biography is displayed in a window; see also [0066] where a pop-up quote or trivia question is displayed).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to display text, as taught in Wistendahl, in addition to displaying graphics, as taught in Broadwin, because text is commonly used to convey information used in advertisements, infomercials and other forms of information sharing (see Wistendahl [0064] where displaying text is an expected function for advertisements).

8. Claims 11- 14, 25-28 and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broadwin et al. as applied to claims 1, 15 or 29 above, and further in view of Wistendahl et al.

Regarding claims 11, 25 and 39, Broadwin does not teach tracking a cursor position on the television screen, wherein identifying the selected item comprises identifying the selected item in dependence upon the cursor position when the selection signal is received.

Wistendahl teaches the use of a mouse or other pointing device which is tracked to correlate the screen coordinates of the pointing device with what the user has selected (see [0015], [0016], [0042], [0067], [0088]).

Furthermore, regarding claims 12, 26 and 40, Broadwin does not teach wherein the identifying the selected item in dependence upon the cursor position further comprises determining whether the cursor position is within a screen region associated with the item.

Wistendahl also teaches determining whether a pointing device or cursor is aimed at a hot spot (screen region associated with the item) or at positions of objects (see [0015], [0016], [0042], [0067], [0088]).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to use the tracking techniques associated with using a pointing device, as taught in Wistendahl, to select objects on the display screen, as taught in Broadwin, because pointing devices, and the methods associated with using pointing devices, are commonly used to facilitate user interaction with visually displayed selectable options.

Regarding claims 13, 27 and 41, Broadwin does not explicitly disclose wherein the advertising content comprises a web page describing the item and offering an on-line sale of the item.

Wistendahl teaches initiating an internet connection to a WWW service which offers an item for purchase (see [0043], [0064]).

Furthermore, regarding claims 14, 28 and 42, Broadwin does not explicitly disclose wherein displaying the associated non-intrusive interactive advertising content comprises downloading a web page from a remote web site identified in a link associated with the selected item.

Wistendahl also teaches where a web page can be downloaded through a link associated with a selected item (see [0043], [0064]).

At the time the invention was made it would have been obvious, to one of ordinary skill in the art, to offer advertisements for sales of items in addition to doing so by providing access to remote web sites, as taught in Wistendahl, to expand upon the media server services, as taught in Broadwin, because expanding upon the means by which information can be retrieved, unlimited types and varieties of interactive actions can be activated (see [0043]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON THOMAS whose telephone number is (571)270-

5080. The examiner can normally be reached on Mon. - Thurs., 8:00a.m. - 5:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Chow can be reached on (571) 272-7767. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. Thomas

/Lun-Yi Lao/
Primary Examiner, Art Unit 2629